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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,233	03/22/2004	Wen-Cheng Tseng	58268.00370	9041
32294 7590 01/16/2007 SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			EXAMINER SORRELL, ERON J	
			ART UNIT	PAPER NUMBER
			2182	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/805,233

Applicant(s)

TSENG ET AL.

Examiner

Eron J. Sorrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/22/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Drawings*

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim(s) 1-21 of U.S. Patent No. 6,738,833 contain(s) every element of claim(s) 22-42 of the instant application and as such anticipate(s) claim(s) 22-42 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)."  
ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

6. Referring to claim 22, it is unclear to the Examiner if the second determining step, the fetching step, and the changing step are performed in response to the initial determining step, or if those action occur independently of the initial determining step. Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 22-25, 27-32, 34-39, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egbert et al. (U.S. Patent No. 6,407,960 hereinafter "Egbert") in view of Chieng et al. (U.S. Patent No. 6,035,346 hereinafter "Chieng").

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9. Referring to method claim 22 and apparatus claims 29 and 36, Egbert teaches a method for flexibly configuring default values of a network device through an memory interface, comprising:

determining whether default values are obtained through the memory interface (see lines 31-42 of column 3);

performing the steps of:

receiving a header from an memory through the memory interface (see line 43 of column 3 to line 25 of column 4);

determining from the header whether any default value of the network device should be updated (see line 43 of column 3 to line 25 of column 4);

fetching at least one configuration instruction from the memory when the determining step determines that the network device should be updated (see line 43 of column 3 to line 25 of column 4);

interpreting the at least one configuration instruction (see line 43 of column 3 to line 25 of column 4); and

changing a register default value of the default values corresponding to the interpreted at least one configuration instruction (see line 43 of column 3 to line 25 of column 4).

Egbert fails to teach that when it is determined that the default values are obtained through a microprocessor interface,

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changing said default values according to data received through the microprocessor interface.

Chieng teaches, in an analogous system, the above limitation (see lines 46-57 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system and method of Egbert with the above teachings of Chieng. One of ordinary skill in the art would have been motivated to make such modification because Chieng suggests the method is less susceptible to reprogramming instruction errors (see paragraph bridging columns 2 and 3).

10. Referring to method claim 23 and apparatus claims 30 and 37, Egbert teaches monitoring a reset signal to determine whether the default values of the network device should be updated (see lines 43-60 of column 3).

11. Referring to method claim 24 and apparatus claims 31 and 38, Egbert teaches determining from the header whether any default values should be updated comprises determining a number of the default values of the network device that should be updated (see line 43 of column 3 to line 25 of column 4; Note

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that each header (MSB) determines if one register is to be updated).

12. Referring to method claim 25 and apparatus claims 32 and 39 Egbert teaches the fetching of at least one configuration instruction from the memory comprises fetching a number of configuration instruction from the memory equal to the number of the default values of the network device that should be updated (see line 43 of column 3 to line 25 of column 4; Note that each header (MSB) determines if one register is to be updated and fetches the corresponding one configuration instruction).

13. Referring to method claim 27 and apparatus claims 34 and 41 Egbert teaches the at least one configuration instruction comprises a plurality of configuration instructions and the step of fetching at least one configuration instruction from the memory is repeated until all of the plurality of configuration instructions have been fetched (see line 43 of column 3 to line 25 of column 4).

14. Referring to method claim 28, and apparatus claims 35 and 42, Egbert the memory interface comprises an EEPROM interface and the method further comprises a step of receiving a header



from an EEPROM through the EEPROM interface (see lines 14-25 of column 3).

15. Claims 26,33, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egbert in view of Chieng as applied to claims 22,29, and 36 above, and further in view of Gates et al. (U.S. Patent No. 5,727,207 hereinafter "Gates").

16. Referring to method claim 26 and apparatus claims 33 and 40, Egbert fails to teach determining a key value from the header and comparing the key value with a magic number pre-defined inside the network device to determine whether any default value of the network device should be updated.

Gates teaches, in an analogous method and apparatus, determining a key value from the header and comparing the key value with a magic number pre-defined inside the network device to determine whether any default value of the network device should be updated (see paragraph bridging columns 2 and 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the method and apparatus of Egbert with the above teachings of Gates. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make such

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modification in order to be able to leave registers with the default configuration values as suggested by Gates (see paragraph bridging columns 2 and 3).

### *Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following U.S. Patent is cited to further show the state of the art as it pertains to the applicant's invention:

U.S. Patent No. 5,909,686 teaches a method and system for configuring a network switch with a memory.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J. Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EJS

January 6, 2007



**KIM HUYNH**  
**SUPERVISORY PATENT EXAMINER**

1/8/06